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54. (New) The method of claim 53, wherein said monitoring step further comprises the steps of:
receiving a notification message from said vehicle;
assuming that said vehicle is traveling along a predetermined route at a predetermined rate of travel until said receiving step; and
determining a location of said vehicle based on said assuming step.

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55. (New) The method of claim 53, wherein said receiving a vehicle indicator and a location indicator step includes the step of receiving, from said user, an activation request that includes said vehicle indicator, said location indicator, and contact information, and wherein said transmitting step includes the step of transmitting said message based on said contact information.

REMARKS

This is a full and timely response to the non-final Office Action of March 29, 2000. Reexamination, reconsideration, and allowance of the application and all presently pending claims are respectfully requested.

Upon entry of this First Response, claims 1-11, 13, 14, 16-23, 27-32, 35-39 and 41-44 remain pending in this application. Claims 1, 3-5, 10, 11, 13, 18-23, 27, 31, 32, 35, and 39 have been directly amended herein, and claims 41-55 have been newly added. Note that new claims 45, 49, and 53 respectively correspond to claims 1, 13, and 31, as originally filed. Furthermore, claims 12, 15, 24-26, 33, 34, and 40 have been canceled without prejudice or disclaimer. It is believed that the foregoing amendments and additions add no new matter to the present application.

The cancellation of claims 12, 15, 24-26, 33, 34, and 40 serves to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicant reserves the right to pursue the subject matter of canceled claims 12, 15, 24-

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26, 33, 34, 39, and 40 in a continuing application, if Applicant so chooses, and does not intend to dedicate any of the canceled subject matter to the public.

Response to §102 Rejections

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. See, e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

Furthermore, "the fact that an application has named a different inventive entity than a patent does not necessarily make that patent prior art." *Applied Materials Inc. v. Gemini Research Corp.*, 15 U.S.P.Q.2d 1816, 1818 (Fed. Cir. 1988). "(A)n applicant's own work, even though publicly disclosed prior to his application, may not be used against him as a reference, absent the existence of a time bar to his application." *In re DeBaun*, 214 U.S.P.Q. 933, 935 (C.C.P.A. 1982). Therefore, an applicant may overcome a rejection based on a patent "by showing that the patent disclosure is a description of applicant's own previous work. Such a showing can be made by proving that the patentee was associated with applicant (e.g. worked for the same company) and learned of applicant's invention from applicant." M.P.E.P. §2136.05; see also *In re Mathews*, 161 U.S.P.Q. 276 (C.C.P.A. 1969).

see 08/05/19

Claim 1

Claim 1 presently stands rejected under 35 U.S.C. §102 as allegedly being anticipated by *Ross*. Claim 1, as amended, reads as follows:

1. A system for automatically reporting upon travel status of vehicles in response to activation requests by users at remote locations, comprising:
a data manager configured to receive an activation request, said activation request including a vehicle indicator and a location indicator, said data manager further configured to automatically correlate said vehicle indicator with a vehicle and said location indicator with a location along a route of travel of said vehicle, to automatically identify a proximity based on said location indicator, to track travel of said vehicle based on travel data received from said vehicle, said travel data identifying said vehicle, and to automatically transmit a message in response to a determination that said vehicle is within said identified proximity; and
a communications interface configured to receive said activation request from a user at a remote location, to automatically transmit said activation request to said data manager, to receive said message from said data manager, and to transmit said message to said user. (Emphasis added).

Applicant respectfully asserts that *Ross* fails to disclose at least the features of claim 1 highlighted hereinabove and that the rejection to claim 1, therefore, should be withdrawn.

In this regard, the present invention, as described by pending claim 1, describes an automated system capable of tracking vehicles and of reporting when a particular vehicle is within a specified proximity of a particular location. The reporting is *automatically* activated in response to an activation request, from a remote user, that includes a vehicle indicator and a location indicator. The vehicle indicator identifies a vehicle that the remote user would like tracked, and the location indicator identifies a location that is used to determine when a notification message should be transmitted to the remote user. For example, when the system of the present invention determines that the vehicle is within a certain proximity of the identified location, the system may be configured to transmit a notification message to the remote user in order to notify the user of impending arrival of the vehicle at a particular destination. Since the activation of the reporting is

automatic, the system is capable of tracking a large number of vehicles and/or of handling a large number of activation requests.

Applicant has reviewed *Ross* and can find nothing in *Ross* to indicate that reporting of vehicle arrivals in *Ross* is automatic in response to activation requests from remote users. Accordingly, Applicant submits that *Ross* fails to disclose at least the features of pending claim 1 highlighted hereinabove, and the rejection to claim 1, as presently set forth, should be withdrawn.

Furthermore, in addition to the reasons set forth above, Applicant submits that *Ross* is inadequate to reject claim 1 under 35 U.S.C. §102 because *Ross* fails to disclose at least the features of a “data manager” that tracks travel of a vehicle “based on travel data received from said vehicle, *said travel data identifying said vehicle*” and that transmits a message to a remote user when the vehicle is within a specified proximity, as described by pending claim 1. (Emphasis added).

In this regard, the vehicle controller 10 of *Ross* is configured to track travel of a vehicle and to transmit a notification message when an estimated time of arrival of the vehicle is less than a predetermined interval. See col. 4, line 53, through col. 5, line 8. Since the controller 10 is located on the vehicle being tracked by the controller 10, there is no need for data identifying the vehicle to be included in the travel data used by the controller 10 to track the vehicle. In particular, data from receiver 18 is used by the controller 10 to determine the location of the vehicle, and all of the data received by the controller 10 from the receiver 18 pertains to the vehicle being tracked by the controller 10. As a result, there is nothing in *Ross* to indicate that the signals received from receiver 18 (*i.e.*, the signals used by controller 10 to track travel of the vehicle) identifies the vehicle, as described by pending claim 1.

For the foregoing reasons, Applicant respectfully submits that *Ross* fails to disclose each feature of claim 1, as presently set forth. Therefore, the rejection to claim 1 under 35 U.S.C. §102 should be withdrawn.

Improper Prior Art Reference

SEE 08/052,119
Applicant further submits that the subject matter disclosed by *Ross* and used by the Office Action to reject pending claim 1 is the product of Applicant's own previous work, and *Ross*, therefore, should not be used to reject the aforementioned claim. In this regard, Applicant submits Exhibits A - I under 37 C.F.R. §1.132 in support thereof.

In particular, Applicant asserts in Exhibit A that Applicant invented the subject matter relied on to reject the pending claims of the present application and that Applicant disclosed the subject matter to Mr. John Ross in efforts of obtaining financing for Applicant's invention. It is Applicant's belief that Mr. Ross had no conception of an advance notification system prior to the Applicant's disclosure to Mr. Ross. Once Applicant disclosed the advance notification system to Mr. Ross, Mr. Ross did suggest the use of a card reader system to implement on the vehicles of the advance notification system (see paragraph 5 of Exhibit A), but Mr. Ross had no further technical input. After Mr. Ross failed to obtain financing, the Applicant and Mr. Ross parted company, and Mr. Ross later filed patent applications including the subject matter invented by the Applicant and disclosed to Mr. Ross.

Exhibits B - H tend to show that Applicant's assertions in Exhibit A are truthful and accurate. In this regard, Exhibit B shows that a relationship between the Applicant and Mr. Ross existed prior to the filing dates of the patents granted to Mr. Ross. Furthermore, Exhibit C shows that this relationship was terminated, as claimed by the Applicant in paragraph 4 of Exhibit A, once

Mr. Ross failed to raise sufficient funds. Exhibit D shows that Mr. Ross at least conceded that the Applicant is an inventor of the advance notification system by signing a non-disclosure agreement that listed Applicant as an “inventor” (see also paragraph 6 of Exhibit A). Note that Mr. Ross is not listed as an inventor on the non-disclosure agreement. Exhibits E - H submitted herewith show that third parties met with Applicant and Mr. Ross and discussed the advance notification system. Each of these third parties believed that Applicant, and not Mr. Ross, was the inventor of the product being discussed.

In particular, Mr. Mark Stubbins stated that he and the Applicant “met with Mr. Ross for the sole purpose of having him help us raise money ... Mr. Ross’s only involvement was his ‘finding capital’ for starting a company to exploit the technology. He had no substantive input on the ideas or concepts associated with the advance notification system. The advance notification system was conceived of and its design was well defined in both system implementations, *long before Mr. Ross was involved.*” (Emphasis added). See paragraph 12 of Exhibit E submitted herewith. Furthermore, Mr. Stubbins reviewed a claim of the ‘444 patent to Mr. Ross and stated that the apparatus described by these claims was invented by Applicant and disclosed to Mr. Ross “before Ross thought about or knew anything about this ‘apparatus.’” (See paragraph 18 of the foregoing Exhibit).

Ms. Gena Payne also reviewed the same claim of the ‘444 patent and asserted that the subject matter of the claim was disclosed to her by Applicant and that “Ross made no claim to have invented (the apparatus), in whole or in part.” See paragraph 6 of Exhibit F. In fact, Ms. Payne stated that “it is beyond amazing that John Ross can actually claim that he is the inventor of any technology surrounding the advance notification field.” See paragraph 5 of the foregoing Exhibit. Furthermore, Ms. Payne (as well as Mr. Anthony Hunt) also stated that Mr. Ross *admitted* to them

that the advance notification system was Applicant's idea and that Mr. Ross was helping to raise money. (See paragraphs 3 and 4 of Exhibit F submitted herewith and paragraph 12 of Exhibit G submitted herewith).

Furthermore, Mr. Rusty Gordon, once a vice president at GTE, also met with Applicant and Mr. Ross regarding the advance notification system. Mr. Gordon stated that he understood Applicant to be the inventor and Mr. Ross to be a financial advisor at the meeting. (See paragraph 8 of Exhibit H). Mr. Gordon also reviewed the same claim reviewed by Mr. Stubbins and Ms. Payne and stated that he discussed all of the elements of the claims "before Kelly (Applicant) met John Ross." See paragraph 9 of the foregoing Exhibit.

Consequently, Applicant respectfully asserts that Exhibits A - I submitted herewith sufficiently prove that Applicant, not *Ross*, invented the subject matter which was disclosed by the *Ross* patent and relied upon to reject the pending claims of the present application and that Mr. Ross derived this subject matter from Applicant. Accordingly, for the reasons set forth hereinbefore, the *Ross* patent is not a proper prior art reference.

Claims 2-11

Claims 2-11 presently stand rejected in the Office Action under 35 U.S.C. §102 as allegedly being anticipated by *Ross*. Applicant submits that the pending dependent claims 2-11 contain all features of their respective independent claim 1. Since claim 1 should be allowed, as argued hereinabove, pending dependent claims 2-11 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Furthermore, the present invention, as defined by pending claim 10, includes a data manager that assumes a vehicle travels according to a predetermined rate. In other words, the data

manager assumes that the vehicle is on schedule. As a result, when the vehicle is actually on schedule, the data manager can be aware of the vehicle's actual location without the vehicle manager having to transmit a message to the base station manager. When the vehicle is off schedule, a data manager on the vehicle transmits travel data to the data manager described by pending claim 10 so that the data manager of claim 10 is aware that the vehicle is off schedule. This travel data is preferably indicative of the actual location of the vehicle. Therefore, the data manager of claim 10 can be aware of the vehicle's location with a minimal amount of communication messages transmitted between the vehicle and the data manager, especially when the vehicle is on schedule for at least a portion of the vehicle's route.

There is nothing in *Ross* to indicate that the system described by *Ross* utilizes such optimizing techniques. Therefore, *Ross* fails to disclose at least the features of a "vehicle manager" configured to "transmit said travel data in response to a determination that said vehicle is off schedule" and a data manager "configured to assume that said vehicle is on schedule unless said data manager receives said travel data transmitted from said vehicle." Accordingly, Applicant respectfully submits that *Ross* fails to disclose each feature of pending claim 10, and Applicant requests that the rejection to claim 10 be withdrawn, notwithstanding the allowability of claim 1.

Claim 13

Claim 13 presently stands rejected under 35 U.S.C. §102 as allegedly being anticipated by *Ross*. Claim 13, as amended, reads as follows:

13. A system, comprising:

a data manager configured to receive a vehicle indicator and a location indicator, to identify a proximity based on said location indicator, to identify a vehicle based on said vehicle indicator, to monitor travel of said vehicle, to analyze travel data indicative of whether said vehicle is within said proximity, to determine whether to transmit a message based on said travel data and said vehicle indicator, and to transmit said message in response to a determination that said vehicle is within said proximity;

a communications interface configured to receive said vehicle indicator and said location indicator from a user at a remote location, to transmit said vehicle indicator and said location indicator to said data manager, to receive said message from said data manager, and to transmit said message to said user. (Emphasis added).

Applicant respectfully asserts that *Ross* fails to disclose at least the features of claim 13 highlighted hereinabove and that the rejection to claim 13, therefore, should be withdrawn.

As set forth in the arguments for allowance of pending claim 1, the controller 10 of *Ross* transmits notification messages to remote users when the vehicle coupled to the controller 10 is estimated to arrive at a particular destination within a certain amount of time. However, there is nothing to indicate that the controller 10 determines whether or not to transmit such a message based on a vehicle identifier received from a remote user. Accordingly, Applicant respectfully submits that *Ross* fails to disclose “a data manager” configured to “determine whether to transmit a message *based on* said travel data and *said vehicle indicator*” and “a communications interface” configured to transmit the message to a user at a remote location, as described by pending claim 13. (Emphasis added). Since *Ross* fails to disclose each feature of claim 13, Applicant submits that the rejection to claim 13 should be withdrawn.

Furthermore, for the same reasons set forth hereinabove in the arguments for allowance of claim 1, Applicant submits that Mr. Ross derived from Applicant the subject matter that is being used to reject pending claim 13 and that *Ross* is not a valid prior art reference to claim 13 pursuant to M.P.E.P. §2136.05.

Claims 14 and 16-22

Claims 14 and 16-22 presently stand rejected in the Office Action under 35 U.S.C. §102 as allegedly being anticipated by *Ross*. Applicant submits that the pending dependent claims 14 and 16-22 contain all features of their respective independent claim 13. Since claim 13 should be allowed, as argued hereinabove, pending dependent claims 14 and 16-22 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Claim 23

Claim 23 presently stands rejected under 35 U.S.C. §102 as allegedly being anticipated by *Ross*. However, similar to pending claim 13, claim 23 presently includes a “means for analyzing travel data indicative of whether said vehicle is within said specified proximity” and a “means for determining whether to transmit a message *based on* said analyzing means and *said vehicle indicator*.” (Emphasis added). For the same reasons set forth hereinabove in the arguments for allowance of pending claim 13, Applicant submits that *Ross* fails to disclose at least the foregoing features of claim 23, as presently set forth. Therefore, Applicant respectfully requests that the rejection to claim 23 be withdrawn.

Furthermore, for the same reasons set forth hereinabove in the arguments for allowance of claim 1, Applicant submits that Mr. Ross derived from Applicant the subject matter that is being

used to reject pending claim 23 and that *Ross* is not a valid prior art reference to claim 23 pursuant to M.P.E.P. §2136.05.

Claims 27-30

Claims 27-30 presently stand rejected in the Office Action under 35 U.S.C. §102 as allegedly being anticipated by *Ross*. Applicant submits that the pending dependent claims 27-30 contain all features of their respective independent claim 23. Since claim 23 should be allowed, as argued hereinabove, pending dependent claims 27-30 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Furthermore, pending claim 27 includes the features that the “activation request further includes contact information” and that the transmitting means “transmits said message based on said contact information.” Applicant respectfully submits that *Ross* fails to show the foregoing features of pending claim 27. Therefore, Applicant asserts that the rejection to claim 27 should be withdrawn, notwithstanding the allowability of pending claim 23.

Claim 31

Claim 31 presently stands rejected under 35 U.S.C. §102 as allegedly being anticipated by *Ross*. However, similar to pending claim 1, claim 31 presently includes the following features:

31. A method for automatically activating vehicle status reporting within a vehicle tracking system, comprising the steps of:
receiving a vehicle indicator and a location indicator from a user at a remote location;
identifying a vehicle based on said vehicle indicator;
identifying a proximity based on said location indicator;
receiving travel data identifying said vehicle and indicating a location of said vehicle;
monitoring travel of said vehicle based on said travel data;
determining, based on said monitoring step, whether said vehicle is within said proximity; and
transmitting a message to said user in response to a determination in said determining step that said vehicle is within said proximity. (Emphasis added).

Applicant respectfully submits that there is nothing in *Ross* to indicate that a user who is to receive a notification message may define when the user is to receive a message from the system described in *Ross*. Therefore, *Ross* fails to disclose each feature of claim 39, as presently set forth, and the rejection to claim 39 should, therefore, be withdrawn.

Furthermore, for reasons similar to those set forth hereinabove in the arguments for allowance of claim 1, Applicant submits that *Ross* fails to disclose the steps of “receiving travel data *identifying said vehicle*” and of “transmitting a message to said user” based on the travel the travel data, as described by claim 31. (Emphasis added). Accordingly, *Ross* is inadequate to anticipate at least the foregoing features of claim 31, as amended, and the rejection to claim 31 should be withdrawn.

In addition, for the same reasons set forth hereinabove in the arguments for allowance of claim 1, Applicant submits that Mr. *Ross* derived from Applicant the subject matter that is being

used to reject pending claim 31 and that *Ross* is not a valid prior art reference to claim 31 pursuant to M.P.E.P. §2136.05.

Claims 32 and 35-38

Claims 32 and 35-38 presently stand rejected in the Office Action under 35 U.S.C. §102 as allegedly being anticipated by *Ross*. Applicant submits that the pending dependent claims 32 and 35-38 contain all features of their respective independent claim 31. Since claim 31 should be allowed, as argued hereinabove, pending dependent claims 32 and 35-38 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

In addition, similar to pending claim 10, claim 32 presently includes the step of “assuming that said vehicle is traveling along a predetermined route at a predetermined rate of travel until said receiving step.” For the same reasons set forth hereinabove in the arguments for allowance of pending claim 10, Applicant submits that the foregoing features of claim 32 are not shown by *Ross*. Accordingly, Applicant respectfully asserts that the rejection to claim 32 should be withdrawn, notwithstanding the allowability of claim 31.

Furthermore, pending claim 35 includes the following features:

35. The method of claim 31, *wherein said receiving a vehicle indicator and a location indicator step includes the step of receiving, from said user, an activation request that includes said vehicle indicator, said location indicator, and contact information, and wherein said transmitting step includes the step of transmitting said message based on said contact information.* (Emphasis added).

Applicant submits that the features of claim 35 highlighted hereinabove are not shown by *Ross* and that the rejection to claim 35, therefore, should be withdrawn, notwithstanding the allowability of pending claim 31.

Claim 39

Claim 39 presently stands rejected under 35 U.S.C. §102 as allegedly being anticipated by *Ross*. Claim 39 presently reads as follows:

39. A method for enabling reporting of impending vehicle arrivals, comprising the steps of:
receiving a vehicle indicator and a location indicator from a remote user,
said vehicle indicator identifying a vehicle and said location indicator indicating a location along a route of travel of said vehicle;
identifying a proximity based on said location indicator;
monitoring travel of said vehicle as said vehicle travels along said route; and
transmitting a message to said user, based on said monitoring step, when said vehicle is within said proximity. (Emphasis added).

Applicant respectfully submits that *Ross* fails to disclose the features of claim 39 highlighted hereinabove. In this regard, there is nothing in *Ross* to indicate that a user who is to receive a notification message may define when the user is to receive a message from the system described in *Ross*. Therefore, *Ross* fails to disclose each feature of claim 39, as presently set forth, and the rejection to claim 39 should, therefore, be withdrawn.

Furthermore, for the reasons set forth in the arguments for allowance of pending claim 1, Applicant submits that Mr. *Ross* derived from Applicant the subject matter being used in the Office

Action to reject claim 39 and that *Ross*, therefore, is not a valid prior art reference under 35 U.S.C. §102.

Claims 41-55

Claims 41-55 have been newly added. Claims 45, 49, and 53 respectively correspond to claims 1, 13, and 31, as originally filed. For the same reasons set forth hereinabove in the arguments for allowance of claim 1, Applicant submits that Mr. Ross derived from Applicant certain subject matter disclosed in the *Ross* patent and that the *Ross* patent should not be a valid prior art reference to claims 41-55 pursuant to M.P.E.P. §2136.05.

Response to Provisional Double Patenting Rejections

Claims 1-11, 13, 14, 16-23, 27-32, and 35-38 presently stand provisionally rejected under the judicially created doctrine of double patenting over claims 1-30 of copending Application No. 09/395,497 and claims 1-36 of copending Application No. 09/163,958. Furthermore, claims 1-11, 13, 14, 16-23, 27-32, 35 and 36 presently stand provisionally rejected under the judicially created doctrine of double patenting over claims 1-21 and 23-49 of copending Application No. 08/852,119. Applicant respectfully traverses these provisional rejections and asserts that the claims of the foregoing applications do not suggest each feature of claims 1-11, 13, 14, 16-23, 27-32, and 35-38, as amended. Noting that the foregoing rejections are provisional, Applicant requests that the rejections be withdrawn when the present application is otherwise in a condition for allowance.

Furthermore, claims 1-11, 13, 14, 16-23, 27-32, and 35-38 presently stand rejected under the judicially created doctrine of double patenting over claims 1-16 of U.S. Patent No. 5,623,260, claims 1-15 of U.S. Patent No. 5,657,010, and claims 1-80 of U.S. Patent No. 5,668,543. However,

Applicant submits that the present application claims priority to copending Application No. 08/852,119. Further, Application No. 08/852,119 claims priority to U.S. Patent No. 5,623,260, U.S. Patent No. 5,657,010, and U.S. Patent No. 5,668,543. Therefore, pursuant to 35 U.S.C. §154, any patent that will issue from the present application will have a term that will not exceed any of the terms of the foregoing patents, and as a result, there should be no unjustified term extension on a "right to exclude" that is already granted in any of the aforementioned patents. As such, the double patenting rejections to the pending claims of the present application are not proper, and Applicant respectfully requests that the double patenting rejections be withdrawn.


CONCLUSION

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted ,

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